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Bradford G. Ackerman

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EXAMINER

HOFFMANN, JOHN M

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/844,947
Filing Date: April 27, 2001
Appellant(s): ACKERMAN ET AL.

Walter Douglas
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 25 January 2008 appealing from the Office action mailed 3/17/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 4-9, 13, 15, 20, 21 and 23-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Appellant does not contest the rejection of claim 23 – see at least page 8, lines 5-7 of the Brief– thus it seems proper for the Office to hold that claim 23 does not comply with the written description requirement .

Claim 1 has a limitation relating to depositing particles “while successively translating the deposition surface”; this limitation has neither explicit nor implicit support. This limitation was added to in the 4/16/2004 amendment to overcome a prior art rejection.

No Explicit support:

Examiner's repeated reading of the specification as well as computerized text searching indicates that there is no explicit support for "while successively translating" or "while successive". Appellant has not asserted nor pointed out (by page and line number) any explicit support.

No Implicit support:

The limitation lacks implicit support because "while" and "successively" are mutually exclusive conditions: 'while' means simultaneously, and 'successively' means following each other. It is undisputed that they are mutually exclusive.

The depositing occurs "while" translating, however it cannot also occur "successively" with the translating. Also, the translating cannot be successive with itself - nothing can be successive with itself. Of course one translating step can be successive to another translating step; however there is no support for two successive translating steps. Appellant admits this: Brief, page 18, line 12.

Furthermore, it is noted that at least on pages 2, 7, 8, 10 and 34 of the Brief, that the rejection of claim 23 is not being contested. The rejection of claim 23 is by virtue of its dependence on claim 1. There is no basis for rejection that is unique to claim 23. Since it appears to be that applicant agrees with the finding that claim 23 fails to comply with 35 USC 112, and since the only rationale given to reject claim 23 is the rationale relating to claim 1 - one could construe that applicant agrees that that the rationale relating to "while successively" is proper as it relates to claim 23. Therefore it should also be proper as it relates to claim 1.

It is noted that final office action sets forth additional reasons for the rejection under the first paragraph of section 112. The above is the only basis being maintained in this grounds of rejection. The other basis (i.e. column of solid porous preform, solid porous, and a deposition surface at a temperature below a minimum temperature at which particles can consolidate of claim 1; and the totality of claims 20 and 21) are no longer being utilized as basis to show non-compliance with the 1st paragraph of 35 USC 112.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4-9, 13, 15, 20, 21 and 23-24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Appellant does not contest the rejection of claim 23 – see at least page 10, lines 12-16 of the Brief– thus it seems proper for the Office to hold that claim 23 does not particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “while successively translating” claim 1, line 7 is indefinite as to its meaning. The phrase is self-contradictory since “while” and “successively” are mutually exclusive terms. If a claim contradicts itself necessarily fails to particularly point out and distinctly set forth what is being claimed. One cannot reasonably understand how one could perform a step while successively doing something else.

It is noted that at least on pages 2, 7, 8, 10 and 34 of the Brief, that the rejection of claim 23 is not being contested. The rejection of claim 23 is by virtue of its dependence on claim 1. Since it appears to be that applicant agrees with the finding that claim 23 fails to comply with 35 USC 112, and since the only rationale given to reject claim 23 is the rationale relating to claim 1 - one could construe that applicant agrees that that the rationale relating to "while successively" is proper as it relates to claim 23. Thus it should also be proper as it relates to claim 1.

It is noted that final office action set forth additional reasons for the rejection under the second paragraph of section 112. The above is the only basis being maintained for this grounds of rejection. The other basis (i.e. column of solid porous preform; and that unique to claims 5 and 21) are no longer being utilized as basis to show non-compliance with the 2nd paragraph of 35 USC 112.

(10) Response to Argument

Most of Appellant's arguments are moot - as they pertain to arguments no longer maintained as bases for the rejections. Only the arguments which pertain to "while successively translating" are deemed relevant.

Regarding the 112 (1st Paragraph) argument, it is argued that the rejection is a result of taking the claim language out of context (starting first full paragraph of page 17, Brief). Appellant then explains the *disclosed* invention. However the explanation fails to make any connection between the terms "while" and "successively" with what is

disclosed. It appears that appellant's position is that the terms "while" and/or "successively" can be ignored, because one should just refer to the context.

It is well understood that the quid pro quo for a patent is for inventors to set forth **in the claims**, what the invention is. Appellant's assertion that one looks to the context/specification (and, apparently ignore claim limitations) is not reasonable and would result in an unreasonable burden on the public.

The same or nearly the same argument is offered for the rejection under the 2nd paragraph of 35 USC 112. It is argued that "while successively" was taken out of context. However it is not explained how it was taken out of context. More importantly, appellant appears to not even attempt to put the terms into any sort of context – or otherwise explain the proper context. There does not appear to be any attempt to explain what this phrase means. The Office found that two terms contradict each other - this appears to be undisputed.

It is argued that the specification clearly indicates that the preform is formed in a continuous manner while the bait is being slowly translated upwards. The relevance of this is not understood - none of the claims recite anything related to the direction or speed of the translation. It is unclear if this means that "successively" should be interpreted as "slowly upwards". There is nothing in the record which would suggest that this would be a reasonable interpretation.

Art Unit: 1700

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

John Hoffmann

/John Hoffmann/

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